

**REMARKS/ARGUMENTS**

Claims 1-6, 8, 10, 11-12, and 20 are pending in this application. By this Amendment, claims 1 and 8 are amended and claims 7, 9, 13-14 and 19 are canceled without prejudice or disclaimer. Reconsideration in view of the following remarks is respectfully requested.

Entry of the amended claims is proper under 37 C.F.R. '1.116 since the amendments: (1) place the application in condition for allowance (for the reasons discussed herein); (2) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution without incorporating additional subject matter); and/or (3) place the application in better form for appeal (if necessary). Entry is thus requested.

The Office Action rejects claims 1-6, 8-13 and 19 under 35 U.S.C. §103 over U.S. Patent No. 4,839,745 to Tindall (hereafter "Tindall") and U.S. Patent Publication No. 2002/081787A1 to Ito et al. (hereafter "Ito"). The Office Action rejects claims 7 and 14 under 35 U.S.C. §103 over Tindall, Ito and U.S. Patent No. 6,301,588 to Aoki (hereafter "Aoki"). The Office Action also rejects claim 20 over Tindall, Ito and U.S. Patent No. 6,523,696 B1 to Saito et al. (hereafter "Saito"). The rejections are respectfully traversed.

Independent claim 8 is directed to a method for retrieving digital data from a digital recording medium and sending the reproduced data to a storage device through a digital interface. Claim 8 recites reproducing management information recorded in the digital recording medium when a retrieving request for a given multimedia file is received from a microprocessor

of said storage device; identifying a recording location of the given multimedia file based upon the reproduced management information; searching for the identified location in the digital recording medium and reproducing recorded data from the identified location; converting the reproduced data into transport streams (TS) and transmitting the TS data to the microprocessor of said storage device; and storing the transmitted TS data in a memory of said storage device. By way of a non-limiting example, the system of Figure 2 shows a PC configured to read data streams through a digital interface (e.g., 42 and 51) from a digital recording medium (e.g., 31) used in the DVHS-TVCR, and store the read data streams in a memory (e.g., 53) of the PC.

The Office Action admits that Tindall does not specifically disclose that the recording medium is a digital recording medium, a digital interface and converting reproduced data into transport streams. See page 5, line 9-page 6, line 4 of the Office Action in Section 3. However, the Office Action indicates Ito discloses a data communication apparatus, method, system and programs for data communication process stored in a computer readable storage medium in which apparatuses such as a PC or a digital video tape recorder (VTR) are interconnected using an IEEE 1394 standard interface. The Office Action then concludes it would have been obvious to incorporate the digital VTR of Ito into the system of Tindall to increase the quality of video to be recorded and reproduced. For at least the following reasons, Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness for claim 8 based upon the suggested combination.

As stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where some teaching, suggestion, or motivation to do so is found therein the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified, which Applicant submits they can not, does not render a resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F. 2d 680 16 USPQ2d 1430 (Fed. Cir. 1990). Because the Office Action does not appear to assert that either reference or knowledge generally available contains such motivation, a *prima facie* case of obviousness has not been made.

In contrast to the Office Action's assertion, Applicant respectfully submits that Tindall teaches away from the asserted modification suggested in the Office Action and discloses graphic information may be integrated with digital information on the same analog recording medium and because the analog video information can be directly displayed, ... the video information enjoys an inherently much higher resolution than computer generated graphics. Photographs, motion pictures ... can be read and stored in analog form ... without the need to digitize the information to make it computer compatible. See column 3, lines 4-25. Similarly, Tindall discloses an invention that allows the display of graphic, photographic and motion picture information in analog format, thereby eliminating information lost through digitizing. See lines 12-15 of the Abstract, Figures 1-3 and column 5, line 16, column 7, line 13 of Tindall.

In summary, Applicant respectfully submits that the Office Action uses improper hindsight for the suggested combination and modification since Tindall teaches away from the modification and combination asserted by the Office Action.

For at least the reasons set forth above, Applicant respectfully submits that claim 8 defines patentable subject matter. Claim 1 defines patentable subject matter for at least reasons similar to claim 8. Claims 2-6, 10-12 and 20 depend from claims 1 and 8, respectively, and therefore also define patentable subject matter for at least that reason as well as their additionally recited features and combinations thereof. Claims 9, 13 and 19 are canceled without prejudice or disclaimer. Withdrawal of the rejection of claims 1-6, 8-13 and 19 under §103 is respectfully requested.

With respect to claims 7 and 14, Applicant respectfully submits that the deficiencies set forth above with respect to the combination of Tindall and Ito are not cured by the further combination of Aoki because Aoki also fails to disclose or suggest at least features of reproducing, identifying, searching, converting and storing and combinations thereof as recited in claim 8. Claims 7 and 14 are canceled without prejudice or disclaimer. Withdrawal of the rejection of claims 7 and 14 under §103 is respectfully requested.

With respect to claim 20, Applicant respectfully submits that the deficiencies set forth above with respect to the combination of Tindall and Ito are not cured by the further combination of Saito, as Saito also fails to disclose or suggest at least features of reproducing, identifying, searching, converting and storing and combinations thereof as recited. Accordingly,

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not even the combination of references disclose or suggests the recited features or their combination in claim 20. Withdrawal of the rejection of claim 20 under §103 is respectfully requested.

Accordingly, withdrawal of the rejection of claims 1-14 and 19-20 is respectfully requested.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Carl R. Wesolowski**, at the telephone number listed below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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